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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/311,753	05/14/1999	TSUYOSHI INOUE	Q54370	1662

7590

07/17/2002

SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 PENNSYLVANIA AVENUE N W
WASHINGTON, DC 20037

EXAMINER

BERNATZ, KEVIN M

ART UNIT	PAPER NUMBER
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1773

24

DATE MAILED: 07/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/311,753

Examiner

Kevin M Bernatz

Applicant(s)

INOUE ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2 and 3 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2 and 3 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 20 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Amendments to claims 2 and 4, filed on April 30, 2002, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Request for Continued Examination

3. The Request for Continued Examination (RCE) under 37 CFR 1.53 (d) filed on April 30, 2002 is acceptable and a RCE has been established. An action on the RCE follows.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 2 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Miyahara et al. (JP 08-020751 A). See provided JPO Abstract translation and Machine Translation of the aforementioned Tokkyo Kokai 08-020751 A.

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Regarding claim 2, the claimed invention reads on Miyahara et al. as follows:

Miyahara et al. disclose a sheet which comprises a support comprising a polymer film laminated on one or both surfaces of a non-woven fabric, and a pressure-sensitive adhesive layer formed on one surface of said polymer film opposed to the polymer film surface adhered to the non-woven fabric, wherein said non-woven fabric has a basis weight of 5 to 100 g/m² and said polymer film comprises a thermoplastic polymer (JPO Abstract and Constitution; Figure 1; Machine Translation paragraphs 0007 – 0013 and 0019). The limitation(s) “for protecting paint films of automobiles” is (an) intended use limitation(s) and is not further limiting in so far as the structure of the product is concerned. “[I]n apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. ***If the prior art structure is capable of performing the intended use, then it meets the claim.*** In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.” [emphasis added] *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). See MPEP § 2111.02.

Regarding claim 3, Miyahara et al. disclose a polymer film meeting applicants' claimed limitations (Machine Translation paragraphs 0013 and 0019 and Examples 2 and 3 in Table 1).

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6. Claim 2 is rejected under 35 U.S.C. 102(e) as being anticipated by Seth (U.S. Patent No. 6,129,964).

Regarding claim 2, the claimed invention reads on Seth as follows: Seth discloses a sheet which comprises a support comprising a polymer film laminated on one or both surfaces of a non-woven fabric, and a pressure-sensitive adhesive layer formed on one surface of said polymer film opposed to the polymer film surface adhered to the non-woven fabric, wherein said non-woven fabric has a basis weight of 5 to 100 g/m² and said polymer film comprises a thermoplastic polymer (col. 2, lines 54 – 59; col. 4, lines 14 – 15; col. 5, lines 7 – 25; col. 6, lines 35 – 64; and Figure 3). The limitation(s) “for protecting paint films of automobiles” is (an) intended use limitation(s) and is not further limiting in so far as the structure of the product is concerned.

Claim Rejections - 35 USC § 103

7. Claim 3 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Seth as applied above.

Seth discloses the claimed invention as described above. Seth further disclose a range in thickness overlapping applicants' claimed limitation.

Seth fails to disclose an embodiment meeting applicants' claimed limitations.

However, it would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as the thickness of the polypropylene backing layer through routine experimentation in the absence of a showing of criticality in the claimed thickness, especially given the teaching in Seth

regarding the overlapping range in thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of Seth to use a polymer layer meeting applicants' claimed thickness limitation as taught by Seth given that Seth disclose overlapping ranges in thickness with applicant and it is known that the thinner a layer, the more flexible it is and the thicker the layer the better the impact/wear resistance.

Response to Arguments

8. The rejection of claims 2 - 4 under 35 U.S.C § 102/103 – Various references

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (703) 308-1737. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703) 308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



KMB
July 9, 2002



STEVAN A. RESAN
PRIMARY EXAMINER